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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,590	05/11/2006	Manfred Guggolz	095309.56195US	4808

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EXAMINER

LE, DAVID D

ART UNIT	PAPER NUMBER
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3655

MAIL DATE	DELIVERY MODE
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06/11/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/532,590	Applicant(s) GUGGOLZ ET AL.	
	Examiner David D. Le	Art Unit 3655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>05/12/09; 02/26/09</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This is the third Office action on the merits of Application No. 10/532,590, filed on 11 May 2006. Claims 10-20 are pending.

Documents

2. The following documents have been received and filed as part of the patent application:

- Copy of Foreign Priority Document, received on 04/25/05
- Information Disclosure Statement, received on 04/25/05
- Declaration and Power of Attorney, received on 05/11/06
- Substitute Specification, received on 02/09/06
- Information Disclosure Statement, received on 02/12/08
- Information Disclosure Statement, received on 05/12/09
- Information Disclosure Statement, received on 02/26/09

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 10-20 are rejected under 35 U.S.C. 102(b) as being anticipated by WO**

02/060715 A1 (hereinafter referred to as WO'715).

Claims 10-20:

WO'715 (Figs. 1-4B; paragraphs [0013] – [0036]) discloses a control system for selecting automated transmission system shift strategy comprising:

- A drive machine (i.e., Fig. 1, element 18);
- A transmission (i.e., Fig. 1, element 12);
- A clutch (i.e., Fig. 1, element 20);
- An input brake (i.e., Fig. 1, element 29);
- A control device (i.e. Fig. 1, element 46);
- Wherein the control device makes a selection as a function of selection rules and vehicle parameters and variables as to whether the clutch remains engaged or disengaged when a gear change takes place from an original gear to an intended gear in the transmission (i.e., paragraphs [0029] – [0036]);
- Wherein, when the gear change is carried out with the clutch engaged, the control device operatively synchronizes a rotation speed of a transmission input shaft to an intended rotation speed of the intended gear by controlling the drive machine (i.e., paragraphs [0029] – [0036]);
- Wherein the control device carries out the gear change exclusively with the clutch disengaged after an initial starting-up of the drive train (i.e., paragraphs [0029] – [0036]);
- Wherein the control device carries out a test to determine whether the gear change can be carried out with the clutch engaged and makes the selection based on a result of the test (i.e., paragraphs [0029] – [0036]);

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- Wherein the control device carries out the test as a function of vehicle parameters and variables (i.e., paragraphs [0029] – [0036]);
- wherein the vehicle parameters vary (i.e., paragraphs [0029] – [0036]);
- Wherein the control device operatively synchronizes the rotation speed of the input shaft to the intended rotation speed of the intended gear by using the input brake (i.e., paragraphs [0029] – [0036]);
- Wherein at the start of a downshift gear change, the clutch remains engaged, and the control device operatively drives an actuating element to deselect the original gear, determines a time since the driving of the actuating elements, monitors whether time exceeds a threshold without the original gear having been deselected, disengaged the clutch (i.e., paragraphs [0029] – [0036]); and
- Wherein the stated threshold is dependent on at least one of vehicle parameters, vehicle variables, and variables which describe an environment of the motor vehicle (i.e., paragraphs [0029] – [0036]).

Response to Arguments

5. Applicant's arguments filed 06 March 2009 have been fully considered but they are not persuasive.

Applicants argue, page 4, second paragraph, of the REMARKS, filed on 06 March 2009, "Because the WO'715 reference does not describe or suggest carrying out a shift with the clutch disengaged when there is a malfunction *or at the initial start up* of the drive train, applicants respectfully submit that claim 10 is not anticipated and is allowable."

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Examiner respectfully disagrees because the above argument does not accurately reflect the claimed limitation. Claim 10, lines 13-18 recite the method step:

“carrying out the gear change exclusively with the clutch disengaged under at least one of the following two situations:

after an initial starting-up of the drive train until all of the vehicle parameters and variables which are relevant for the selection have been determined by the control device, and when a malfunction is identified in a component of the drive train.”

Clearly, the claimed limitation is referring to “after an initial starting-up of the drive train”, not at the initial start up of the drive train as argued.

Since the claimed method step is written in alternative form, the applied reference WO’715 is required to meet only one of the alternatives.

As set forth above, WO’715 meets the claimed limitations.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David D. Le whose telephone number is 571-272-7092. The examiner can normally be reached on Mon-Fri (0900-1730).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles A. Marmor can be reached on 571-272-7095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David D. Le/
Primary Examiner, Art Unit 3655
06/09/2009

ddl